



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/049,727 | 06/25/2002 | Yahia Gawad | 3477.93 | 4559 |

20792 7590 09/20/2005

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

EXAMINER

FOSTER, CHRISTINE E

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1641

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,727

Applicant(s)

GAWAD ET AL.

Examiner

Christine Foster

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1641

DETAILED ACTION

Applicant's Preliminary Amendment filed 10/25/01 is acknowledged and has been entered.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-2, 4, 6-7, 12, and 14-24, drawn to a method for determining active PAI-1 comprising a first antibody to PAI-1 and a labeled second antibody to multimeric vitronectin.

Group II, claim(s) 1, 3, 5, 8-9, and 13-24 drawn to a method for determining active PAI-1 comprising a first antibody to multimeric vitronectin and a labeled second antibody to PAI-1.

Group III, claim(s) 1, 10-11, and 14-24, drawn to a method for determining active PAI-1 comprising a labeled third antibody.

Group IV, claim(s) 25 and 27-28, drawn to a kit comprising a PAI-1 antibody and a labeled antibody to multimeric vitronectin.

Group V, claim(s) 26 and 32-33, drawn to a kit comprising a multimeric vitronectin antibody and a labeled antibody to PAI-1.

Group VI, claim(s) 29 and 30-31, drawn to a kit comprising a third labeled antibody.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Art Unit: 1641

The technical feature linking Groups I-VI appears to be the step of measuring the amount of PAI-1/multimeric vitronectin complex in a sample.

However, Lawrence et al. (WO 97/39028; see Information Disclosure Statement filed 8/13/02, Cite No. 1) teach a method of measuring the amount of PAI-1 bound to either native or urea-treated vitronectin (p. 63, lines 3-4 and p. 64, lines 20-33). Urea-treated vitronectin is a multimeric form of vitronectin (see the instant specification, p. 8, lines 18-20).

Therefore, the technical feature linking the inventions of Groups I-VI does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

In addition, Groups I-VI each have technical features that are unrelated to the other groups. Group I is drawn to a method that includes the limitation of a labeled antibody which binds selectively to multimeric vitronectin, while Group II is drawn to a method that includes a labeled antibody to PAI-I; Group III is drawn to a method that includes a labeled third antibody; Group IV is drawn to a kit comprising a labeled antibody which binds selectively to multimeric vitronectin; Group V is drawn to a kit comprising a labeled antibody to PAI-I; and Group VI is drawn to a kit comprising a labeled third antibody.

Accordingly, Groups I-VI are not linked by the same or a corresponding special technical feature so as to form a single general inventive concept.


A telephone call was made to Karen Magry on September 7, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.


Art Unit: 1641

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Foster whose telephone number is (571) 272-8786. The examiner can normally be reached on M-F 8:30-5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached at (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Christine Foster, Ph.D.
Patent Examiner
Art Unit 1641


LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600
09/14/01